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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ni et al.

Attorney Docket No.: PF294D1

Application Serial No.: 09/263,689

Group Art Unit: 1643

Filed: March 5, 1999

Examiner: Canella, K.

For: Galectin 9 Polypeptides

RESPONSE UNDER 37 C.F.R. §1.111

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 21, 2005, please enter and consider the following remarks. Claims 141-172 are pending.

I. Rejections Under 35 U.S.C. §§ 101 and 112, First Paragraph

The Examiner has rejected claims 141-172 under 35 U.S.C. §§ 101 and 112, first paragraph because the claimed invention is allegedly not supported by either a substantial asserted utility or a well established utility. In particular, while the Examiner acknowledges that the references previously cited by Applicants teach a correlation between the eosinophil chemoattractant activity of the polypeptide of SEQ ID NO:4 and asthma, the Examiner asserts that the specification does not make such an assertion "because it contemplates that the claimed polypeptides can be either over expressed or under-expressed in the condition of asthma ... [which] is tantamount to no assertion at all." Claims 141-172 were also rejected under 35 U.S.C. § 112, first paragraph, based on the alleged lack of utility under 35 U.S.C. § 101.

In response, Applicants respectfully disagree and traverse. The specification asserts that galectin 9 is useful for diagnosing and treating disorders including Hodgkin's disease and asthma. *See, e.g.*, page 27, line 20 to page 31, line 11, especially page 29, lines 3-9 and page 30, lines 12-18. The specification also teaches the use of antibodies to galectin 9 to detect these